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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,946	10/04/2001	Jean-Patrick Azpitarte	01-600	4092

7590

02/14/2006

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EXAMINER

CHANKONG, DOHM

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/971,946	AZPITARTE, JEAN-PATRICK	
	Examiner	Art Unit	
	Dohm Chankong	2152	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 24 January 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 13 and 15-26.

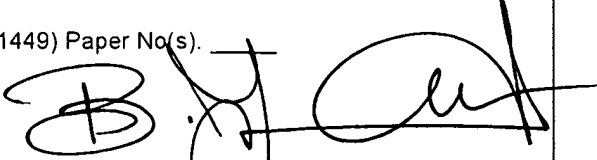
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See attached sheet.


BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

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DETAILED ACTION

- 1> This action is a continuation of the Advisory Action.
- 2> Applicant's amendment is entered as they merely address minor § 112 issues and do not alter the claims in a manner that would require a new prior art search.

Response to Arguments

- 3> Applicant's remarks have been considered but are not persuasive. Applicant argues that provisional application relied upon by Spira et al, U.S Patent Publication No. 2002|0172002 ["Spira reference"] does not comply with 35 U.S.C § 112, first paragraph. Applicant asserts the provisional is not enabling nor does it comply with the written description or best mode requirements.

Written Description

Spira's provisional application satisfies the written description requirement. For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1405 (Fed. Cir. 1997); *Hyatt v. Boone*, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998).

Here, Spira's two page description and brochures adequately conveys that

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Spira was in possession of “modular system” that helps provide technical services to a customer. See Spira provisional, page 1. Spira’s claimed invention is directed towards providing “customer-related technical services” using “software tools and hardware tools”. See claims 1-24. Spira achieves this goal in part by installing modules at various business levels that provide technical services such as consulting, repairs and parts supply. See Spira provisional, page 1. The information in the brochures support the statements made in the description. Thus, Spira’s provisional reasonably conveys to one skilled in the art that he was in possession of his claimed invention.

Enablement

Spira’s provisional is sufficiently enabling to one of ordinary skill in the art to make and use the invention. The fact that experimentation is complex will not make it undue if a person of skill in the art typically engages in such complex experimentation. See MPEP § 2105(V)((B)(2). Additionally, “for a computer-related invention...the specification should disclose...how to integrate the programmed computer with other elements of the invention, unless a skilled artisan would know how to do so without such disclosure. In re Donohue, 550 F.2d 1269, 1271, 193 USPQ 136, 137 (CCPA 1977) (“Employment of block diagrams and descriptions of their functions is not fatal under 35 U.S.C. 112, first paragraph, providing the represented structure is conventional and can be determined without undue experimentation.”)” Id.

Here, Spira’s invention is directed towards a modular system of providing technical services to a customer. Spira’s written description sufficiently details how the modules are to

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be created and implemented throughout the customer's various business levels. The description provides details on how the modules are used to achieve the goals set forth by the disclosure in the brochures. Spira's brochures contain block diagrams and descriptions of the overall invention and system. See Spira brochure [pages 21-22, 37 (of 109) : Spira's block diagrams detailing the invention's implementation].

Spira further discusses other aspects of his invention, including utilizing performance based contracts so companies may monitor the work of the maintenance company and the use of their modules allows for proactive maintenance of the customer's facility. See Spira brochures [pages 33-35].

Based on Spira's description of his modules and the background provided by the brochures, one of ordinary skill in the art would be enabled to make and use the invention. While the experimentation may be complex, it seems that maintenance companies typically engage in such experimentation to provide remote maintenance services to customer facilities. Further, Spira only need provide how the modules would be integrated with other elements of the invention. Spira's description achieves this by detailing that the modules may be implemented as software, the modules integrated at various levels of the customer's facility.

Best Mode

Spira's disclosure does disclose a best mode for his invention. Deficiencies related to disclosure of the best mode for carrying out the claimed invention are not usually encountered during examination of an application because evidence to support such a

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deficiency is seldom in the record. *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1548-49, 41 USPQ2d 1801, 1804 (Fed. Cir. 1997). See MPEP § 2105(V).

Here, Applicant broadly asserts, without support, that Spira suffers from a lack of best mode. The Office submits that Spira's description and brochures provide a best mode of his invention, providing in detail how the modules are integrated to achieve the goal of providing maintenance services to customers.

4> Applicant further argues that disparate elements of Spira's system have been taken independently and combined artificially. Specifically, Applicant asserts that Spira does not disclose a system comprising local units installed near machines to be monitored and comprising means for performing a diagnostic of the condition of the machine, and transmitting the diagnostic information via a network. Applicant's arguments are not persuasive.

Applicant's arguments ignore Spira's specification. As previously discussed, Spira is directed towards utilizing modules, "the modules, which are implemented through software modules and hardware, are installed at a local level in each plant. However, operation and control of the service is provided through regional facilities that are linked to the local facilities by a communication connection, such as through the Internet. The regional facilities are provided at regions around the globe so as to offer 24 hour support to the local service locations, including providing a regional center in the Far East, one in the European Union, and one in a NAFTA country" [0022].

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Spira thus discloses a means for customers to outsource maintenance and monitoring tasks. The regional facilities use programs “implemented either in the computer system of the customer system or on servers of the respective provider center, for instance a Customer Service Center. However, monitoring by the respective Customer Service Center is always a feature, this center being in charge in a country or international regions as well, for example USA and Canada. Communication via the Internet with special measures for secure transmission are provided” [0038].

Clearly, the outsourced maintenance company is responsible for remotely monitoring the customer facility. Sensors are utilized to monitor the facilities, the sensors enabled for “continuous monitoring of the conditions *on-line or telemonitoring* allows the plant to operate at maximum efficiency” [italics provided] [0354, see also claim 28]. Spira clearly contemplates that the sensors are connected to a transmission network, the sensors enabled to transmit its monitored information through the transmission network.

Thus, Spira is directly related to the same problem that concerns Applicant – remotely managing maintenance of facilities, and in fact utilizes the same technology of sensors and a transmission network to aid in the remote monitoring. Applicant’s argument that the Office’s interpretation of Spira is unduly strained is also difficult to understand considering the fact that Applicant utilizes sensors within his invention to achieve the same goals set forth by Spira. See Applicant’s specification [page 6 «lines 11-18»].

5> Applicant asserts that Spira does not disclose allowing a maintenance technician to real time signal the beginning and end of his servicing on a facility. Applicant’s arguments

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fail to address the basis of the rejection, that the functionality of signaling the beginning and end of his service is implied by the functionality of Spira's invention.

Spira discloses: "this leads to pricing 306 of the project. The pricing is determined by specific pricing rules 308 according to the contract and key performance indicators. A quotation is offered and contract negotiations 309 commence. Finally, the contract 310 is prepared, using provided contract forms 312." [0111] and "the performance contracting option features tangible value-added evaluation systems, key performance indicators, a third party validation of asset review, and scheduled reviews. Risks are minimized while the provider and customer enter into a win/win relationship using a performance based fee, at least in part. This could depend not only on the maintenance performance but also on the market condition for the plant. Effectiveness is provided through measured criteria" [0155].

Also, "motivated teams of workers are allowed extensive autonomy through a flat organizational structure so that a high degree of customer focus is provided with benchmarks that set key performance indicators which in turn characterize the way the maintenance personnel approach their work" [0238].

Based on this functionality, Spira is clearly concerned with linking contract pricing towards performance by the maintenance company. One of these method is providing a third party to validate scheduled reviews. A reasonable implication is that maintenance tasks (scheduled reviews) are monitored to insure that the maintenance company is living up to their end of the contract. Thus, the functionality enabling the ability to signal the beginning and end of his service is an implied functionality in Spira, obvious to one of ordinary skill in the art based on a fair and proper reading of his disclosure.

6> In regard to Applicant's arguments of claim 15, Applicant contends the rejection based on functionality of preventing transmissions of malfunctions during an inspection is well known in the art. When performing maintenance on a computer system, it is well known and old in the art that the technician will turn off the computer. Turning off a computer system is generally required to prevent any injury to the computer and technician. Turning off the computer will also prevent the computer from transmitting over the network. Thus, the Office interprets the functionality of the claim 15 as being satisfied by a technician utilizing the on/off switch of the computer system.

7> In regards to Applicant's arguments of the rejection of claim 16, Applicant is directed towards paragraph 0087, disclosing a database that is accessible by computers at any of the local plants.

8> In regards to Applicant's arguments of the rejection of claim 17, Applicant is directed towards 0302, disclosing detection of faults. Displaying a fault signal when a fault has been detected is not a novel invention as it is well known in the art.

9> Based on the preceding remarks, Applicant's arguments are not persuasive, the rejections set forth in the final rejection, filed 9.19.2005, are maintained.

Conclusion

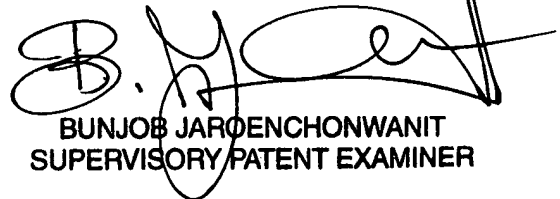
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Monday-Thursday [7:00 AM to 5:00 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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SUPERVISORY PATENT EXAMINER

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